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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/663,145 03/01/91 DAVIES

M 2954/06403

EXAMINER
LEWIS, A

FBM1/0805

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805 THIRD AVENUE
NEW YORK, NY 10022

ART UNIT PAPER NUMBER

3307

DATE MAILED: 08/05/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 12/30/92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-692.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449 (3)
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1 → 26 are pending in the application.
Of the above, claims 22 → 26 are withdrawn from consideration.
- ☐ Claims have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 1 → 21 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
- ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Claims 1-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There remains an inconsistency between the language in the preamble and a certain portion or portions in the body of the claims, thereby making the scope of the claims indefinite.

The preambles of claims 1,8,11,16 indicate that applicant is claiming a subcombination of an inhalation device but the bodies of each of these claims contains at least one positive recitation of structure which indicates that a combination (i.e. inhalation device and medicament pack) is being claimed. Examples of the abovementioned positive recitations from claims 1,8,11,16 include, "...said members...", "...said at least one container...", in claim 1; "...said base sheet...", "...said lid sheet...", "...said plurality of containers...", in claim 8; "...said plurality of containers...", "...said base sheet...", "...said lid sheet...", in claims 11 and 16.

Based on applicant's remarks, it is apparent that applicant intends to claim only the subcombination of an inhalation device; therefore, the body of each of the claims 1-21 in the instant application must be amended to remove any positive recitation of the combination.

Claims 8,11 and 16 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1 and 2 are rejected under 35 U.S.C. § 103 as being unpatentable over Hurka et al..

As to claim 1, Hurka et al. disclose an inhalation device for use with a medicament pack, said medicament pack having at least one container (4) being defined between two members (1,2 and 9) peelably secured to one another (col. 4, lines 34-35). The device further includes an opening station (3), the opening station capable of receiving said at least one container (4), means (9) for peeling (col.4, lines 34-35) and an outlet (8) communicating with the opened container through which a user can inhale medicament in powder form from the opened container.

As to claim 2, the Hurka et al. device is "adapted for use" where the said two members (1,2 and 9) are two sheets.

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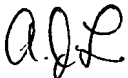
Claims 3-7 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Applicant's arguments with respect to claims 1 and 2 have been considered but are deemed to be moot in view of the new grounds of rejection.

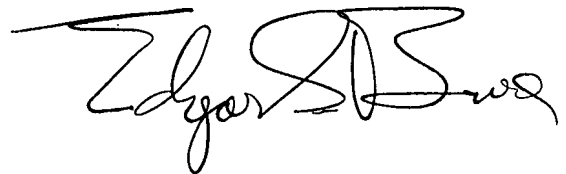
Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Aaron J. Lewis at telephone number (703) 308-0858.



Aaron J. Lewis
August 4, 1993



EDGAR S. BURR
S.P.E.
GROUP ART UNIT 337